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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/037,916	03/10/98	NISHIO	N P8287-8002

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EXAMINER	
MCCARTY, W	
ART UNIT	PAPER NUMBER
2761	13

DATE MAILED: 05/30/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/037,916	Nishio et al.
Examiner	**Group Art Unit**
McCarty	2761

☒ Responsive to communication(s) filed on *Mar 8, 2000*

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *13-19* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *13-19* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

The request filed on March 08, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/037,916 is acceptable and a CPA has been established. An action on the CPA follows.

DETAILED ACTION

This communication is responsive to the Continued Prosecution Application (CPA) filed March 8, 2000 (Paper No. 11) of application **09/037,916** filed March 10, 1998, and a preliminary amendment (Paper No. 12) filed concurrent therewith.

Status of Claims

1. Claims 1-12 were under prosecution in this application at the time of the final Office Action mailed November 08, 1999 (Paper No. 9). The Applicant has requested that the preliminary amendment filed March 08, 2000 (Paper No. 12) be entered with the filing of this CPA, and the arguments in support thereof considered. The preliminary amendment cancelled claims 1-12 and added new claims 13-19. Accordingly, claims 13-19 remain pending in this application and are presented for examinaton on their merits.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida (4,736,094) in view of Read (EFTPOS: electronic funds transfer at point of sale, *Electronics & Communication Engineering Journal*, November/December, 1989) and in further view of Lessin et al. (4,868,376) in view of Cordonnier ("Smart cards: present and future applications and techniques", *Electronics & Communication Engineering Journal*, October, 1991).

As to **claim 13**, *Yoshida* discloses an *electronic purse system* (financial transaction processing system: col.2, lines 60-68) *having a double-structured purse comprising* (col.6, lines 12-58; Figs.1&4)*: an IC card* (integrated circuit card: col.2, lines 60-68). However, Yoshida does not disclose the use of a cipher program in relation to the payment processing system. Lessin et al. discloses a ciphering/de-ciphering program (Lessin, encryption, col. 3, lines 36-56, col. 4, lines 24-53) and a payment processing system with a processor for executing payment processing according to the payment processing program stored in said memory (Lessin, col. 3, lines 36-56, col. 4, lines 24-53). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine the processing and ciphering as disclosed by Lessin et al. with the system of Yoshida as Cordonnier ("Smart cards: present and future applications and techniques", *Electronics & Communication Engineering Journal*, October, 1991), teaches the use of various components in smart card and integrated circuit card technology (Cordonnier, pg. 208, col. 3, pg. 209, cols. 1-2). Also, Read discloses a means for encrypting data to be transmitted, and means for decrypting encrypted data which is received, thereby preventing interception or interference (encryption, decryption, Figs. 9-11, pg. 268, cols. 2-3, pg. 268, cols. 1-3, pg. 270, col. 1, ¶1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the encryption of Read in the system of Yoshida as Cordonnier ("Smart cards: present and future applications and techniques", *Electronics & Communication Engineering Journal*, October, 1991) teaches the use of encryption in the integrated circuit card technology (Cordonnier, pg. 207, cols. 1-2) so that *a first terminal group which can transfer money to the IC card, wherein each terminal in the first group includes a first ciphering/deciphering unit which performs ciphering/deciphering of information relating to money utilizing a code number; a second terminal group which can transfer money to the IC card, wherein each terminal in the second group does not perform ciphering/deciphering of the information related to money; and the IC card, including a) a first purse, b) a second purse, and c) a second ciphering/deciphering unit for ciphering/deciphering of the information related to money obtained from one of the terminals in the first terminal group utilizing the code number, wherein, when making a payment from the first purse, information relating to the money is transferred between the first purse and*

the one terminal of the first terminal group after ciphering of the information in the first and second ciphering/deciphering units in the IC card and in the terminal of the first terminal group, and wherein, when making a payment from the second purse, the information related to the money is transferred between the second purse and one of the terminals of the second terminal group without ciphering of the information.

As to **claim 14**, *Yoshida* discloses an *IC card* (integrated circuit card: col.2, lines 60-68) *applicable to an electronic purse system* (financial transaction processing system: col.2, lines 60-68) *having a double-structured purse comprising* (col.6, lines 12-58; Figs.1&4):

a first purse for storing a first amount of money therein;

a second purse for storing a second amount of money therein. However, Yoshida does not disclose the use of a cipher program in relation to the payment processing system. Lessin et al. discloses a ciphering/de-ciphering program (Lessin, encryption, col. 3, lines 36-56, col. 4, lines 24-53) and a payment processing system with a processor for executing payment processing according to the payment processing program stored in said memory (Lessin, col. 3, lines 36-56, col. 4, lines 24-53). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the processing and ciphering as disclosed by Lessin et al. with the system of Yoshida as Cordonnier ("Smart cards: present and future applications and techniques", *Electronics & Communication Engineering Journal*, October, 1991), teaches the use of various components in smart card and integrated circuit card technology (Cordonnier, pg. 208, col. 3, pg.

209, cols. 1-2). Also, Read discloses a means for encrypting data to be transmitted, and means for decrypting encrypted data which is received, thereby preventing interception or interference (encryption, decryption, Figs. 9-11, pg. 268, cols. 2-3, pg. 268, cols. 1-3, pg. 270, col. 1, ¶1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the encryption of Read in the system of Yoshida as Cordonnier ("Smart cards: present and future applications and techniques", *Electronics & Communication Engineering Journal*, October, 1991) teaches the use of encryption in the integrated circuit card technology (Cordonnier, pg. 207, cols. 1-2) so that *a first ciphering/deciphering means for ciphering/deciphering of information relating to money obtained from a first terminal having a second ciphering/deciphering unit and utilizing a code number, wherein, when making a payment from the first purse, information is transferred between the first purse and the first terminal after ciphering of the information in the first and second ciphering/deciphering units in the IC card and in the first terminal, and wherein, when making a payment from the second purse, information is transferred between the second purse and a second terminal without ciphering of the information.*

As to **claim 15**, *Yoshida* as modified and applied to claim 14 above discloses the *IC card according to claim 14, wherein when a terminal requesting payment from said IC card does not specify from which purse payment is to be made from, said payment is made from said second purse* (col.3, lines 35-68; col.4, lines 1-32).

As to **claim 16**, *Yoshida* as modified and applied to claim 15 above discloses the *IC card according to claim 15, wherein when said first purse is specified, communication between said IC card and said terminal uses said first ciphering/deciphering unit* (Encryption,decryption, Figs. 9-11, p.268; col.2-3, p.268; cols.1-3, p.270; col.1, paragraph 1).

As to **claim 17**, *Yoshida* as modified and applied to claim 14 above discloses the *IC card according to claim 14, wherein when said code number is not verified upon deciphering, payment is not made from either purse* (Encryption,decryption, Figs. 9-11, p.268; col.2-3, p.268; cols.1-3, p.270; col.1, paragraph 1).

As to **claim 18**, *Yoshida* as modified and applied to claim 14 above discloses an *IC card transaction apparatus according to claim 14, wherein when said first purse is specified for making payment and the amount of money in the first purse is not sufficient, then payment from said second purse is made* (col.3, lines 35-68; col.4, lines 1-32).

As to **claim 19**, *Yoshida* as modified and applied to claim 14 above discloses an *IC card according to claim 14, wherein said code number is received from the terminal, payment is made from said first and second purses, and when said code number is not received from said terminal, payment is made only from said second purse* (col.3, lines 35-68; col.4, lines 1-32).

Conclusion

4. Any inquiry concerning this communication from the Examiner should be directed to Will McCarty whose telephone number is (703) 305-0625.

5. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 305-0040 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Will McCarty
May 22, 2000

FRANTZY POINVIL
PRIMARY EXAMINER
AU 2768